

REMARKS

The Final Office Action mailed November 15, 2010 has been received and carefully considered. Claims 1-23, 25-50, and 52-70 are pending in the application. No new matter has been added. Claims have been cancelled as indicated above without waiver or disclaimer. Entry of the amendments to the claims and reconsideration of the outstanding rejections in the present application are requested based on the following remarks.¹

Rejection of Claims 1-17, 19-23, 25-50, 52-60, and 70 under 35 U.S.C. 102(e)

Claims 1-17, 19-23, 25-50, 52-60, and 70 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,405,175 to Ng ("Ng"). Applicant respectfully traverses this rejection and submit that Ng fails to anticipate the claimed embodiments.

It is well understood that for a proper anticipation rejection, all claim limitations must be taught or suggested by the prior art and the claim elements must be arranged or combined in the same way as recited in the claim. This baseline standard for anticipation under 35 U.S.C. § 102 was reiterated by the Federal Circuit in *Net Moneyin v. Verisign*, 88 USPQ2d 1751, 1759 (Fed. Cir. 2008), holding:

We thus hold that unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.

¹ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

Furthermore, a “reference must clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [invention] without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.” *Sanofi-Synthelabo v. Apotex, Inc.*, 89 USPQ2d 1370, 1375 (Fed. Cir. 2008) (emphasis and alterations in original) (quoting *In re Arkley*, 172 USPQ 524 (CCPA 1972)).

In order to maintain an anticipatory rejection under 35 U.S.C. §102, a reference must teach each and every element of the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” MPEP § 2131 (quoting *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)).

Ng Fails to Anticipate Independent Claim 1

Ng discloses “a searchable database [that] contains information submitted by rewarded users.” Col. 3, lines 23-24. Ng’s database contains product information, such as price. *See, e.g.*, Fig. 4. Ng also discloses that users with accounts can earn rewards for using Ng’s database. *See, e.g.*, col. 7, lines 61-67. As such, Ng fails to “teach[] a method for tracking promotion of at least on [*sic*] group of products” as alleged by the Office on page 2 of the Office Action. Applicant notes that the Office comments on Applicant making this statement and alleging that the Applicant is arguing that the preamble carries patentable weight. *See* Office Action, p. 13.

However, the Office has misconstrued Applicant’s remarks. Applicant was not using the preamble as a limitation, but was merely responding to the Office’s assertion regarding what Ng

allegedly teaches, as is shown by Applicant quoting language from the Office Action and not the claims, for example.

To address the Office's rejections and comments, Applicant has amended claim 1 as indicated above to clarify the structure of the claimed embodiments, particularly in view of the Office's comments regarding certain elements not being given patentable weight.

Claim 1 recites, *inter alia*:

the database server being further configured to issue a credit certificate, that is usable as a coupon, rebate, or refund by the user and the user is notified of the pre-set value being accumulated, to the account of the user upon a pre-set value of non-zero valuation credits being accumulated in the user account.

Applicant respectfully submits that Ng fails to disclose this element. Ng, as mentioned above and noted by the Office, discloses rewards. *See* Office Action, p. 14. Ng's rewards "can later be converted into prizes." Col. 9, lines 25-26. However, Ng fails to disclose a *credit certification, that is usable as a coupon, rebate, or refund by the user* as recited. The Office relies upon the background section of Ng, *e.g.*, col. 1, lines 15-22, as allegedly disclosing this element. As Applicant has previously noted, this is the background and combining this disclosure with Ng's later disclosed invention, involves a combination of elements which renders Ng non-anticipatory. Stated differently, Ng fails to disclose a database server configured as recited by at claim 1.

Therefore, in view of the preceding remarks, the Examiner has failed to present a *prima facie* case of anticipation for at least independent claim 1. Applicant respectfully requests the withdrawal of the anticipation rejection of claim 1.

Independent claims 25, 44, 50, 59, 60, and 70, although differing in scope, recite similar elements to independent claim 1, and are therefore allowable for at least the reasons given for independent claim 1 above since Ng fails to anticipate the recited elements of those claims also.

The Dependent Claims Are Allowable

Dependent claims 28-38, 44-49, and 54-58 depend from one of independent claims 25, 44, and 50, and thus incorporate all the elements of the respective independent claims and are therefore allowable for at least the reasons set forth above.

Rejection of Claims 18 and 61-69 under 35 U.S.C. 103(a)

Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ng in view of U.S. Patent No. 5,895,075 to Edwards (“Edwards”). Claims 61-69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ng in view of U.S. Patent No. 5,623,547 to Jones (“Jones”). Applicant respectfully traverses these rejections.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). There are four separate factual inquiries to consider in making an obviousness determination: (1) the scope and content of the prior art; (2) the level of ordinary skill in the field of the invention; (3) the differences between the claimed invention and the prior art; and (4) the existence of any objective evidence, or “secondary considerations,” of non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *see also KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). An “expansive and flexible approach” should be applied when determining obviousness based on a combination of prior art references. *KSR*, 127 S. Ct. at 1739. However, a claimed invention combining multiple known elements is not rendered obvious simply because each element was known independently in the prior art. *Id.* at 1741. Rather, there must still be some “reason that would have prompted” a person of ordinary skill in the art to combine the elements in the specific way that he or she did. *Id.* Also, modification of a prior art reference may be obvious only if there exists a reason

that would have prompted a person of ordinary skill to make the change. *KSR*, 127 S. Ct. at 1740-41.

Dependent Claim 18 is Patentable over Ng in View of Edwards

Dependent claim 18 depends from independent claim 1. Accordingly, claim 18 is allowable at least based on this dependency. Furthermore, Applicant respectfully submits that the secondary reference of Edwards fails to cure the deficiencies of Ng as described above. Therefore, claim 18 is allowable over the cited art and Applicant respectfully requests the withdrawal of the rejection.

Independent Claim 61 is Patentable over Ng in View of Jones

Independent claim 61 recites, *inter alia*:

wherein further the user can transfer value from the at least one account associated with the user to at least one account belonging to a second user of the front end service.

The Office, on page 11 of the Office Action, admits that Ng fails to disclose at least this element. The Office relies upon Jones as allegedly curing this deficiency of Ng. Applicant respectfully disagrees.

Jones' disclosure is related to cashless transaction systems, such as credit and debit cards. Jones discloses a "value transfer system which allows value to be transferred between electronic purses." Abstract. Jones discloses the transfer of funds from a user to a retailer. See col. 1, lines 14-19. However, Jones fails to disclose transferring value from *the user* to an account of *a second user of the front end service*.

First, the retailer of Jones is not a second user of the front end service. The retailer is a different entity from the user disclosed by Jones. As shown by the plain language of the claim, the user and the second user are similar entities and both have accounts. Jones' disclosure refers

to payment from a customer to a retailer, such as in a credit transaction. Indeed, Jones disclosure is focused on such transfers, not transfers between *users* who have *accounts* associated with the system. The Office even tacitly admits as much as page 12 of the Office Action - “[Jones] teaches fund transfer between specific customer and the specific retailers.” Jones’ fund transfer between a customer and a retailer is not equivalent to the transfer of the claimed embodiment. Further, one of ordinary skill in the art would appreciate a user and a retailer to be different from the *user* and the *second user* of recited claim. Applicant respectfully submits that the Office is failing to consider the claim as a whole in accordance with basic obviousness principles. See MPEP § 2142.02(I) and (II)

Therefore, Applicant respectfully submits that the combination of Ng and Jones fails to render at least claim 61 obvious. Applicant respectfully requests that the rejection be withdrawn.

Dependent Claims 62-69 Are Allowable

Dependent claims 62-69 depend from claim 61, and thus incorporate all the elements of the independent claim and are therefore allowable for at least the reasons set forth above.

CONCLUSION

In view of the foregoing amendments and arguments, it is respectfully submitted that this application is now in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether personal or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to the favorable disposition of the application.

It is believed that no fees are due for filing this Amendment. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicant also authorizes the Director to charge all required fees, fees under 37 C.F.R. §1.17, and all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

Date:

1/13/11



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